

Remarks

The Rejection of Claims 1-3, 6, 15-16, and 18-20 under 35 U.S.C. §103(a)

The Examiner rejected the above-identified claims under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,588,050 (Urban), of record, in view of U.S. Patent No. 2,114,037 (Spokes), U.S. Patent No. 1,789,133 (Bluhm), U.S. Patent No. 839,074 (Miner), U.S. Patent No. 726,339 (Player), or U.S. Patent No. 995,067 (Jones), newly cited. Applicant traverses the rejection and respectfully requests reconsideration.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Applicants submit that Spokes contains no teachings regarding the use of friction material for the rigid structure. Spokes teaches the use of frictional material to fill a hole in the surface of a frictional material of a brake shoe, not to provide rigid structure for securing a brake shoe to a backing element. Further, Spokes teaches that the brake shoe is retained by elements made of materials other than frictional materials. “After a *fastening means such as the bolt M* (emphasis added) has been inserted into an opening H, a plug as P1 is forced into the opening...” Page 2, first column, lines 57-59. Thus, Spokes not only fails to teach the use of frictional material for the rigid structure, but also very clearly teaches against the use of frictional material for the rigid structure. Therefore, Applicants submit that Spokes contains no teaching, suggestion, or motivation applicable to *prima facie* obviousness regarding the present invention. Hence, in the argument that follows, “secondary references” refers only to Bluhm, Miner, Player, and Jones.

When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references and the teachings of the references can be combined only if there is some suggestion or incentive to do so. *In Re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002), citing *In re Fine*. Hence, elements of separate patents cannot be combined when there is no suggestion of such combination in those patents. *Panduit Corp. v. Dennison Manufacturing Co.*, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987). Additionally, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art

also suggests the desirability of the combination. *In re Mills* 16 USPQ2d 1430. Thus, the question of motivation to combine references is material to patentability and cannot be resolved on subjective belief and unknown authority. *In Re Lee, supra*. Indeed, “to imbue one of ordinary skill in the art with knowledge of the invention ... when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *Id*; *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303 (Fed. Cir. 1983). The Examiner must also explain the reasons one of ordinary skill in the art would have been motivated to select the references and combine them to render the claimed invention obvious. *In Re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002); *In re Rouffet*, 47 U.S.P.Q.2d 1453.

In the present case, none of the prior art references cited by the Examiner contain an explicit or implicit teaching, suggestion or motivation to create the subject invention and none teach, suggest, or motivate one to combine/modify their respective teachings with others to create the subject invention.

In general, Urban contains no teaching, suggestion, or motivation to change the material used to fabricate his retainers. Urban is solving the problem of making a brake pad that is removable with respect to a backing element. “It is another object of this invention to provide a brake shoe that is simple in construction yet provides effective *removable securement* (emphasis added) between a support member and a frictional lining.” Col 1, lines 60-63. In Col. 3, lines 34-37, Urban states: “The use of retainers 34 hereinbefore described provide a simple and low cost means of removeably securing liner 8 to a support member enabling it to be *easily removed* (emphasis added) for replacement or repair...” None of the secondary references teaches this central aspect of Urban or contain any suggestion or motivation regarding this aspect. The respective frictional liners of Miner, Player, and Jones are all cast about the respective retaining elements, and therefore are in essence permanently attached to these elements. The frictional element of Bluhm also is permanent. “For this purpose, the whole is *pressed in the hot state* (emphasis added) ...” Page 1, lines 74-75. Thus, one would not select Bluhm, Miner, Player, or Jones for any teaching regarding a brake shoe removeably attached to a backing means.

Further, the teachings, suggestions, and motivations regarding the material of construction for

the retainer in Urban are all directed toward the strength of the material with respect to securing the retainer to the backing member. “Retainer 34 preferably is made from a hollow tube made from a suitable material that is compatible with the material from which liner 8 is made and *possesses sufficient strength* (emphasis added) to firmly secure liner 8 to member 2 and maintain the securement under the forces arising from repeated braking.” Urban clearly shows the retainer is made of a material different than the frictional liner and contains no teaching, suggestion, or motivation to make the retainer of a frictional material. Thus, Urban contains no teaching, suggestion, or motivation to select the secondary requirements.

Each of the secondary references teaches a composite frictional liner formed by a primary frictional element and a frictional/retainer element connected to a backing element. Both the primary and the retainer elements are exposed at the surface of the brake shoe. That is, each of the secondary references teaches that the retainer must be exposed at the surface of the frictional liner. This is very different than the monolithic frictional liner and “buried” retainer of Urban. In fact, these secondary references teach away from Urban, since Urban is only concerned with a retainer that is concealed within the frictional liner. Thus, one would not select Bluhm, Miner, Player, or Jones for any teaching regarding a brake shoe having a retaining means completely concealed by a brake shoe. Likewise, one would not select Urban regarding a brake shoe having exposed retainers.

Miner, Player, and Jones all stress the function of their respective retainers in holding together the cast portion of the respective brake shoe. “... the lugs or prongs...extend through the body of the shoe from back to front ... to strengthen the cast portion and to lock and tie all parts thereof together,” Miner, page 1 lines 42-50. “...and if the cast-iron should become fractured to a very considerable extent it is still all held firmly together by the steel plate.” Player, page 1, lines 64-67. “The supporting member, in addition, strengthens the cast metal body portion of the shoe and holds the parts of the body portion together...” Jones, page 2, lines 25-28. Thus, Miner, Player, and Jones are directed to yet another problem not considered in Urban, providing further evidence that one would not look to Miner, Player, or Jones for teachings regarding Urban’s problem of an easily removed retainer.

For the reasons set forth above, Applicants respectfully submit that none of the references cited by the Examiner, considered individually and collectively, contain sufficient, teaching,

suggestion or motivation to combine or modify their teachings with those of others to create the subject invention.

Applicants respectfully submit that, with respect to Claims 1, 15, and 18, Urban and the secondary references fail to satisfy the requirements for establishing a *prima facie* case of obviousness in accordance with MPEP § 2143. Therefore, Claims 1, 15, and 18 are patentable over Urban in view of the secondary references and Applicants respectfully request that the rejection be withdrawn. Claims 2, 3, and 6 depend from Claim 1 and therefore, also are patentable over the cited prior art. Claim 16 depends from Claim 15 and therefore, also is patentable over the cited prior art. Claims 19 and 20 depend from Claim 18 and therefore, also are patentable over the cited prior art.

The Rejection of Claims 17 and 21 under 35 U.S.C. §103(a)

The Examiner rejected Claim 17 and 21 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,588,050 (Urban) in view of the secondary references as applied to Claims 15 and 18 above, and further, in view of U.S. Patent No. 5,601,174 (Schultz). Applicant traverses the rejection and respectfully requests reconsideration.

Claims 17 and 21 depend from Claims 15 and 18, respectively. As noted above in Applicants' arguments regarding Claims 1, 15, and 18, Claim 15 and 18 are patentable over Urban in view of the secondary references. Schultz teaches the article or apparatus being a clutch, and therefore, does not cure the defects of Urban and the secondary references with respect to Claims 15 and 18. That is, Schultz does not teach, suggest, or motivate any of the limitations of Claims 15 or 18. Thus, Claims 15 and 18 are patentable over Urban in view of the secondary references and further in view of Schultz. Claims 17 and 21, dependent from Claims 15 and 18, respectively, also are patentable over the cited prior art, and Applicants respectfully request that the rejection be withdrawn.

Conclusion

Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested.

Respectfully submitted,



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